

60,469-021
OT-4718**REMARKS**

Applicant respectfully requests reconsideration of this application. The rejection under 35 U.S.C. §112 should be withdrawn. The term surface characteristic is clearly understood in light of the specification and the claims themselves. A dictionary definition of surface is "the exterior or outside of an object or body," for example. A definition of characteristic is "a trait, quality or property distinguishing an individual, group or type," for example. Both of these definitions are taken from *Webster's New International Dictionary*, 2nd Edition. Accordingly, a surface characteristic is a trait or quality of the surface that distinguishes it from another. Therefore, in the context of the claims, a first surface characteristic means that a first surface has a distinguishing quality or trait compared to the second surface with the second surface characteristic. Further, claims 14 and 15 provide further examples of specific surface characteristics where, in claim 15 for example, the first surface characteristic comprises a rough surface while the second characteristic comprises a surface that is smoother than the rough surface.

The rejection under 35 U.S.C. §102(b) based upon the *Spiess* reference should be withdrawn. There is no anticipation. It appears that the Examiner is interpreting the illustration in Figure 2C of that reference as showing different surface characteristics. That drawing must be interpreted in light of the text of that document. Nowhere in *Spiess* does it discuss having different surfaces or different surface characteristics on the outer surface 3 of the steel sheet, hose-like or tube-like covering 4. The indications of the sections 26 in Figure 2C indicate zones and does not indicate a different surface or surface characteristic. Column 4, lines 1-9, clearly teach that different pressures inside of

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the hose-like covering 4 are used to establish "hard unsprung at-rest zones 26."
Therefore, there is no anticipation.

The rejections under 35 U.S.C. §103 must be withdrawn. The claims cannot be considered obvious. To begin with, as noted above, *Spiess* does not disclose different surface characteristics. At best, *Spiess* discloses an arrangement where the hardness on the inside of a steel hose-like covering is varied at different zones. That is not the same as having different surfaces or surface characteristics.

Further, the suggestion by the Examiner that the subject matter of claims 7, 18 and 20 would be an obvious design choice does not establish a *prima facie* case of obviousness. For example, having a plurality of independently removable track portions cannot be considered obvious in view of the teachings of *Spiess*. *Spiess* specifically teaches that the elastic filling 5 or the elastic cushion 17 is "inserted, within hose-like covering 4, over the entire length of a guide rail 16." (Column 3, lines 54-56). It cannot be considered obvious to substitute independently removable pieces because that would eliminate the ability to use a single piece filling 5 or cushion 17. There would be no benefit to having removable pieces when *Spiess* relies on a continuous, one-piece cushion or filling. When a suggested modification would defeat a function or intended purpose of a reference or there would be no benefit, that suggested modification cannot be used to establish a *prima facie* case of obviousness.

Further, there is no benefit to making the other modification suggested by the Examiner and, therefore, that cannot be considered obvious, either.

Claim 19 was rejected under 35 U.S.C. §103 as being unpatentable over the combination of *Spiess* with *Sukale*. Applicant respectfully traverses this rejection. The

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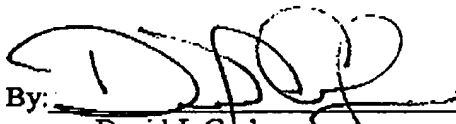
Examiner does not point to any suggestion or motivation within the references to make the combination and there is no apparent benefit, absent what has been disclosed by Applicant, to making that combination (i.e., the additional teachings of *Sukale* do not add anything to the teachings of *Spiess* in a manner that would be useful in light of the teachings of *Spiess*) and, therefore, there is no *prima facie* case of obviousness.

Because claims 22-28 have been withdrawn from consideration, Applicant has cancelled those claims above.

This case is in condition for allowance and Applicant respectfully requests an early notification of the same.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE

I hereby certify that this Response is being facsimile transmitted to Examiner Thuy Van Tran, Patent and Trademark Office (Fax No. (703) 872-9327) on August 12, 2002.


Theresa M. Palmateer

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